

Response to March 29, 2005, Office Action
Atty Dkt No. 01-0159-CIP-2
Application No. 10/759,562

REMARKS

In the Office Action under reply, claims 1-29 are pending. Claims 25-27 and 29 have been indicated as withdrawn from consideration. The examined claims stand rejected as follows:

1. Under 35 U.S.C. §102(b) as anticipated by Dressman et al., Lloyd, Shafice et al., Urbain et al., Berhold et al., or Fan et al. (claims 1 and 28);
2. Under the judicially created doctrine on obviousness-type double patenting over claims 1-29 and 33 of copending U. S. Patent Application Serial No. 10/759,555 (claims 1-24 and 28);
3. Under the judicially created doctrine on obviousness-type double patenting over claims 1-4, 6-22, and 24-29 of copending U. S. Patent Application Serial No. 10/198,237 (claims 1-24 and 28); and
4. Under the judicially created doctrine on obviousness-type double patenting over claims 1-24 and 28 of copending U. S. Patent Application Serial No. 10/346,684 (claims 1-24 and 28).

In the present amendment, claim 1 has been amended. Thus, claims 1-29 remain pending in the application with claims 25-27 and 29 standing withdrawn.

The Examiner's rejections and objections are addressed, in part, by the above-amendments and are otherwise traversed by the arguments presented below.

THE AMENDMENTS TO THE CLAIMS

Claim 1 has been amended to remove hydrogen and optionally substituted lower alkyl from the list of possible X¹ substituents. No new matter has been added and entry of the above amendment is in order.

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THE REJECTION OF CLAIMS 1 AND 28 OVER 35 U.S.C. §102(B)

The Examiner has rejected claims 1 and 28 over the disclosure of Dressman et al., Lloyd, Shafiee et al., Urbain et al., Berhold et al., and Fan et al. specifically referencing the disclosure of compounds wherein:

T is oxygen, sulfur, or NR¹¹;

V is -N<;

X¹ is hydrogen;

X² is optionally substituted aryl;

Y is optionally substituted monocyclic heteroarylenyl; and

Z¹ and Z² are independently optionally substituted alkylene of 1-4 carbon atoms.

As independent claim 1 has been amended to exclude hydrogen and optionally substituted lower alkyl from the permitted list of X¹ substituents, Dressman et al., Lloyd, Shafiee et al., Urbain et al., Berhold et al., and Fan et al. fail to disclose compounds that anticipate the compounds of the claimed invention.

As the Examiner is aware, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). In the present instance, the failure of all of the six references to teach any compounds wherein X¹ is other than hydrogen or lower alkyl, clearly removes the references as a proper basis for a rejection under 35 U.S.C. §102.

With respect to the rejection over Lloyd and Shafiee et al., Applicants would like to point out that the rejections are also in error as the compounds in Lloyd and Shafiee et al. contain X² substituents that are neither optionally substituted aryl nor optionally substituted heteroaryl. As the Examiner will see, the compound taught by Lloyd and Shafiee et al. actually have 2,3-dihydro-inden-1-yl moieties at this position, which do not fall within the definitions of either of the allowed substituents.

Reconsideration and withdrawal of the rejection are in order and are respectfully requested.

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**THE OBVIOUSNESS-TYPE DOUBLE PATENTING REJECTION OVER U. S. PATENT
APPLICATION SERIAL NO. 10/759,555**

The Examiner has provisionally rejected claims 1-24 and 28 under the judicially created doctrine on obviousness-type double patenting over 1-29 and 33 of copending U. S. Patent Application Serial No. 10/759,555 (the '555 application). Applicants traverse this rejection as the '555 application is not prior art to the present application and the compounds cited therein do not render the subject matter of the currently pending claims obvious.

Looking first at the issue of the status of the '555 application as prior art, Applicants wish to remind the Examiner that the present application is a C-I-P application of copending U. S. Patent Application Serial No. 10/346,684, filed January 17, 2003, which is a C-I-P of copending U. S. Patent Application Serial No. 10/198,237, filed July 18, 2002, which claims priority to provisional application 60/306,621, filed July 19, 2001.

As the '555 application has a filing date of January 16, 2004, and claims priority to Provisional application 60/440,936, filed January 17, 2003, it cannot be cited as prior art against the current application. The subject matter of the current application was clearly supported by the '936 provisional application and is, therefore, entitled to the July 18, 2002, priority date, a date that is well in advance of the January 17, 2003, priority date of the '555 application.

Applicants would also like to point out that the subject matter of the two applications in no way overlaps. The currently pending claims contain a optionally substituted monocyclic heteroarylenyl in the Y position. The term "heteroarylenyl" is defined in the current application as follows:

The term "heteroarylene" or "heteroarylenyl" refers to a diradical of a heteroaryl group as defined above. (See page 12, lines 14-19, of the current application)

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In contrast, the claims in the '555 application contain an optionally substituted dihydroheteroaryl moiety in the Y position. The term "dihydroheteroaryl" is defined in the '555 application as follows:

The term "dihydroheteroaryl" refers to a heteroaryl group as defined above in which one double bond has been saturated, and one double bond remains unsaturated. That is, a partially saturated heteroaryl group. (See pager 14, lines 9-12, of the '555 application)

Contrary to the Examiner's assertion, these two definitions do not overlap. The Y groups in the '555 must have one of the double bonds in the heteroarylenyl saturation while the Y groups in the current application must remain unsaturated.

The aforementioned point regarding the incorrect interpretation of the Y groups is, however, moot in view of the filing date of '555 application. The reference is not prior art and does not contain overlapping subject matter. Withdrawal of the rejection is requested.

THE OBVIOUSNESS-TYPE DOUBLE PATENTING REJECTION OVER U. S. PATENT APPLICATION SERIAL NO. 10/198,237

The Examiner has provisionally rejected claims 1-24 and 28 under the judicially created doctrine on obviousness-type double patenting over claims 1-4, 6-22, and 24-29 of copending U. S. Patent Application Serial No. 10/198,237 (the '237 application), which is the grandparent application to the present C-I-P application..

In response to the obviousness-type double patenting issue raised by the Examiner, applicants are submitting a Terminal Disclaimer with the present communication, disclaiming the terminal portion of any patent issuing on the present continuing application that would extend beyond the term of any patent issuing on copending U. S. Patent Application Serial No. 10/198,237. Submission of this Terminal Disclaimer is not

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intended as acquiescence in the double patenting rejection, but is solely for the purpose of expediting prosecution.

Reconsideration and withdrawal of the rejection are accordingly in order and are respectfully requested.

**THE OBVIOUSNESS-TYPE DOUBLE PATENTING REJECTION OVER U. S. PATENT
APPLICATION SERIAL NO. 10/346,684**

The Examiner has provisionally rejected claims 1-24 and 28 under the judicially created doctrine on obviousness-type double patenting over claims 1, 3-35, and 43 of copending U. S. Patent Application Serial No. 10/346,684 (the '684 application), which is the parent application to the present C-I-P application..

In response to the obviousness-type double patenting issue raised by the Examiner, applicants are submitting a Terminal Disclaimer with the present communication, disclaiming the terminal portion of any patent issuing on the present continuing application that would extend beyond the term of any patent issuing on copending U. S. Patent Application Serial No. 10/346,684. Submission of this Terminal Disclaimer is not intended as acquiescence in the double patenting rejection, but is solely for the purpose of expediting prosecution.

Reconsideration and withdrawal of the rejection are accordingly in order and are respectfully requested.

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CONCLUSION

For the foregoing reasons, Applicants submit that the claims are in condition for allowance. A Notice of Allowance is requested, and a prompt mailing thereof would be much appreciated.

Should the Examiner have any questions, he is invited to contact the undersigned attorney at (650) 384-8755.

Respectfully submitted,

Date: 6/2/05

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